

REMARKS

Claims 1 and 7-64 are all the claims pending in the application.

The specification is amended herein to correct minor clerical and typographical errors.

No new matter is presented.

I. Response to Claim Rejections Under 35 U.S.C. §112, 2nd Paragraph

Claims 7, 8, 12 and 40 are rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite.

In paragraph 2 of the Action, the Examiner states that the language "the polyolefin" in claims 7 and 8 has no antecedent basis. The Examiner further request clarification of the term "an age register agent" in claims 12 and 40.

With respect to claims 7 and 8, Applicants submit that the claim 7 recites "polyolefin resin" in line 3 and properly refers to "the polyolefin resin" in line 5 of the claim. Similarly, claim 8 recites "polyolefin based resin" in line 3 and properly refers to "the polyolefin based resin" in line 5.

As for the term "age register agent", Applicants submit that this agent is discussed in the specification on page 27, line 24 to page 25, line 11. An age register agent is used to avoid oxidizing deterioration as described in the paragraph bridging pages 27 and 28 of the specification. The term "agent" was inadvertently omitted in the specification, but the specification is amended herein to correct this minor error.

Accordingly, Applicants respectfully request withdrawal of the rejection.

II. Response to Claim Rejections Under 35 U.S.C. §103

Claims 1, 7-12, 29-40 and 57-64 are rejected under 35 U.S.C. §103 as allegedly being unpatentable over Yamamoto et al or Rau et al.

Claims 18-28 and 46-56 are rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Yamamoto et al or Rau et al and further in view of Ryoke et al.

Claims 13-17 and 41-45 are rejected under 35 U.S.C. §103 as allegedly being unpatentable over Yamamoto et al or Rau et al and further in view of Sasaki et al.

In each of these rejections the Examiner relies on Yamamoto et al or Rau et al as the primary reference for disclosing the claimed carboxylated acrylonitrile-butadiene rubbers.

Applicants respectfully traverse the rejection and submit that the cited references, whether taken alone or in combination, do not teach or suggest the present claimed invention. Specifically, neither one of Yamamoto et al or Rau et al disclose, teach or suggest the element of a carboxylated acrylonitrile-butadiene rubber as recited in the present claims. Both Yamamoto et al and Rau et al teach hydrogenated nitrile rubber compositions. Neither one of Yamamoto et al or Rau et al teaches carboxylated acrylonitrile rubbers as recited in the claims.

Further, neither of Ryoke et al or Sasaki et al remedies this deficiency of Yamamoto et al or Rau et al. In this regard Sasaki et al teaches a polyamide rubber blend composition wherein the rubber composition component is a blend of an acrylonitrile-butadiene copolymer and epichlorohydrin rubber. The disclosed blend of an acrylonitrile-butadiene copolymer and epichlorohydrin rubber is different from the claimed composition consisting essentially of carboxylated acrylonitrile-butadiene and a polyolefin resin as recited in independent claim 7, from which claims 13-17 depend. That is the additional element of the epichlorohydrin rubber

in the rubber composition and the lack of a polyolefin resin selected from the group consisting of a carboxylic acid modified polyethylene and carboxylic acid modified polypropylene would materially alter the basic and novel characteristics of the claimed invention as recited in claims 13-17. Thus, one of ordinary skill would not have been motivated to combine the references as suggested by the Examiner.

Similarly in regard to claims 41-45, one of ordinary skill in the art would not have been motivated to combine the teachings of the references with a reasonable expectation of success to the claimed invention as recited in claims 41-45 which ultimately depend from claim 8, since the combination of references does not teach or suggest a carboxylated acrylonitrile-butadiene rubber and a polyolefin based resin selected from the group consisting of a carboxylic acid modified polyethylene and carboxylic acid modified polypropylene.

Even if one were motivated to combine the references as suggested by the Examiner, the present invention as recited in claims 13-17 or 41-45 would not have been achieved.

With respect to the rejection of claims 18-28 and 46-56 under 35 U.S.C. § 103 as allegedly being unpatentable over Yamamoto et al or Rau et al and further in view of Ryokey et al, Applicants note that Ryokey et al is non-analogous art. Each of Yamamoto et al and Rau et al are directed to a hydrogenated nitrile rubber composition. The composition of Yamamoto et al is disclosed as being useful in various sealing materials, hoses, belts and rolls. The composition of Rau et al is disclosed as being useful in tires and a variety of other automobile parts and motorized vehicles and machines. However, Ryokey et al relates to a magnetic recording medium for audio equipment, video deck and computers. Col. 1, lines 5-11.

For a reference to be considered analogous art, the reference must either be in the field of Applicant's endeavor or reasonably related to the problem with which the invention is concerned. See MPEP § 2141.01(a). In this regard, Ryoke et al's recording mediums are not in the field of Applicants' endeavor of a rubber material composition for use as sealing members of rolling devices.

Therefore, the question is whether one of ordinary skill in the art at the time of the invention would have even selected Ryoke et al without the advantage of hindsight and knowledge of the present specification. *See In re Antle*, 444 F.2d 1168 (CCPA 1971). In this regard Applicants note that it has been established that defining the problem with which Applicants were faced in terms of the solution is improper hindsight in the selection of the prior art applied by using the invention as an editing standard of the most applicable references out of a vast array of inapplicable and misleading references. *See, Monarch Knitting Machinery Corporation, et al v. Sulzer Moratt, et al.*, 139 F.3d 877 (Fed. Cir. 1998). In this case Ryoke et al is not reasonably related to the problem with which the invention is concerned, i.e., a rubber composition to be suitably used for sealing members in rolling devices and that it is only with the advantage and knowledge of Applicants' specification describing the use of the rubber composition claimed as the solution to the problem with which Applicants were faced at the time of the invention, that the Examiner selected Ryoke et al as a reference. Thus, the Examiner has engaged in improper hindsight in selecting Ryoke et al as a reference by using Applicants' teachings in the specification of the solution to the identified problem as an editing standard for selecting Ryoke et al from a vast array of inapplicable references.

Thus, one of ordinary skill in the art would not have been motivated to combine the references as suggested by the Examiner.

In view of the above, Applicants submit that the Examiner has not made a *prima facie* showing of obviousness with respect to the claimed invention for at least the reason that the cited references do not teach or suggest a carboxylated acrylonitrile-butadiene rubber as recited in the present claims. Further, there is no motivation for one of ordinary skill in the art to arrive at the specific compositions recited in the present claims with respect to the amounts of each of the components of the claimed composition. Thus, the claimed invention is not rendered obvious by the cited references, whether taken alone or in combination.

Accordingly, Applicants respectfully request withdrawal of the rejections.

III. Conclusion

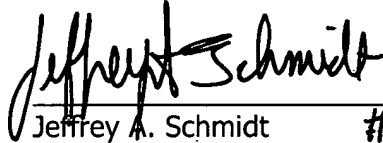
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. APPLN. NO. 10/804,142

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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